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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,004	03/31/2004	James Caron	CPEQ 2 00004 (II)	6058
27885	7590	07/18/2005	EXAMINER	
FAY, SHARPE, FAGAN, MINNICH & MCKEE, LLP 1100 SUPERIOR AVENUE, SEVENTH FLOOR CLEVELAND, OH 44114			COLILLA, DANIEL JAMES	
			ART UNIT	PAPER NUMBER

2854

DATE MAILED: 07/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary

Application No.

10/814,004

Applicant(s)

CARON, JAMES

Examiner

Daniel J. Colilla

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-29 is/are allowed.
- 6) ☐ Claim(s) 1-4, 6, 8-15, 17 and 18 is/are rejected.
- 7) ☒ Claim(s) 5, 7, 16 and 19-22 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| <p>1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)</p> <p>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)</p> <p>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/9/05</u>.</p> | <p>4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.</p> <p>5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)</p> <p>6) <input type="checkbox"/> Other: _____.</p> |
|---|--|

DETAILED ACTION

1. The indicated allowability of claim 3 is withdrawn in view of the newly discovered reference(s) to Haumont (US 2,056,321). Rejections based on the newly cited reference(s) follow.

Claim Objections

2. Claims 8 and 19 are objected to because of the following informalities:

In claim 8, lines 2-3, "a first pressing" appears to be a double recitation of the same that was recited in claim 6. This objection could be overcome by reciting --the-- or --said first pressing.-- Similarly, "a second pressing" appears to be a double recitation.

In claim 19, lines 2-3, "the embossing template" has no antecedent basis in the claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

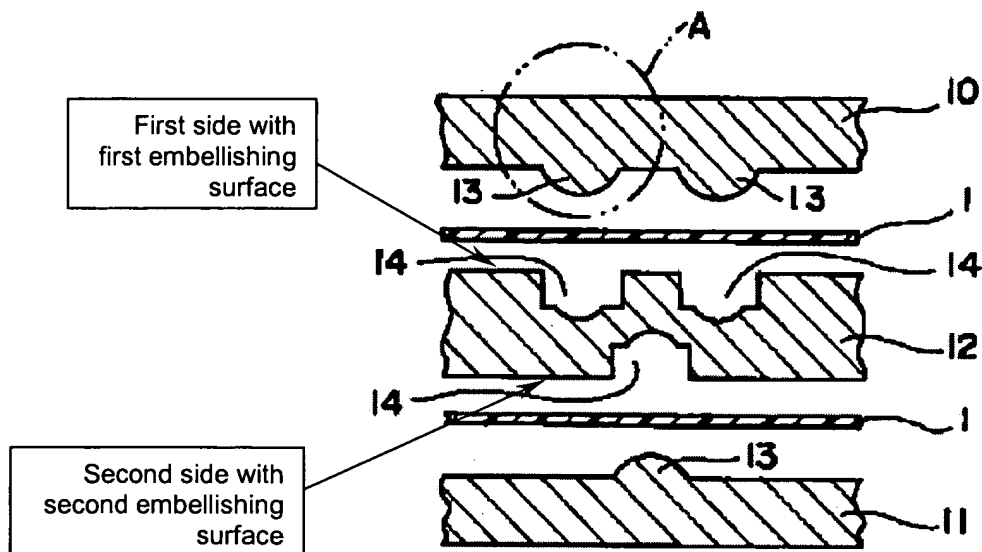
3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-2, 4, 6, 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Motoki et al. (JP 10-199360).

With respect to claim 1, Motoki et al. discloses a media embellishing die 12 including the structure as shown in the Figure below taken from Figure 1 of Motoki et al.:



Each surface of die 12 is used for embellishing media 1 that is pressed against the surfaces of the die.

With respect to claim 2, as shown above, the first and second sides are on opposite sides of the die 12.

With respect to claim 4, the surfaces shown above are embossing surfaces as disclosed in the last sentence of the "Solution" portion of the English abstract.

With respect to claim 6, this claim only contains functional recitations of how the media embellishing die is to be used. The die 12 has the capability to be used in this manner. The die 12 could be used in one pressing as shown in the above Figure and then the die 12 could be turned over and pressed at a different portion of, for example the lower media 1.

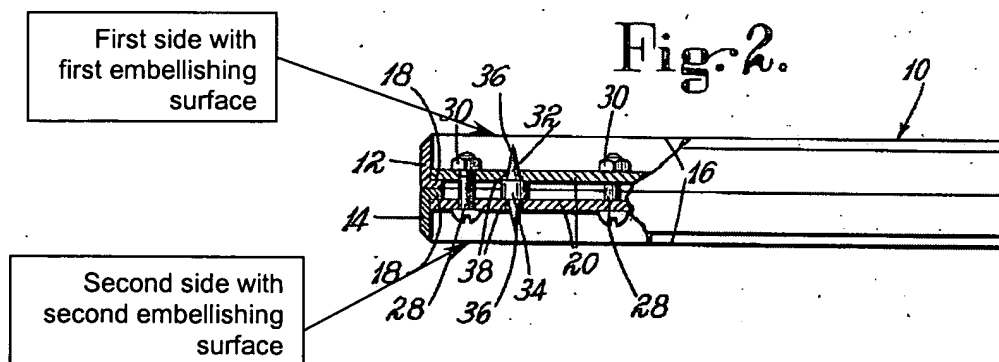
Art Unit: 2854

With respect to claim 8, this claim also only contains functional recitations of how the die is to be used. The die 12 disclosed by Motoki et al. could be used in this manner by applying different pressures to the die in each pressing operation.

With respect to claim 9, Motoki et al. discloses that the die 12 is made of metal in the second line of the "Solution" portion of the English abstract.

5. Claims 1, 3, 9, 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Haumont (US 2,056,321).

With respect to claim 1, Motoki et al. discloses a media embellishing die 10 including the structure as shown in the Figure below taken from Figure 2 of Haumont:



Each surface of die 10 is used for embellishing media that is pressed against the surfaces of the die (Haumont, pg. 1, col. 2, lines 29-32).

With respect to claim 3, as shown in Figure 1 of Haumont, each side 12 and 14 of the die has a cutter 16 for cutting media.

With respect to claims 9-10, Haumont discloses that the die cutting blades sections 12 and 14 can be made of steel strip 22 (Haumont, pg. 1, col. 2, lines 19-25).

6. Claims 1 and 9-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsuda (JP 8-090720).

With respect to claim 1, Figure 3 of Tsuda shows an embellishing die with first and second sides that can be used for embellishing media pressed against each of the sides.

With respect to claims 9 and 10, the die disclosed by Tsuda contains metal foil 7 that can be aluminum as disclosed in lines 1-3 of the "Constitution" portion of the English abstract.

7. Claims 12, 15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirano (US 5,722,319).

With respect to claim 12, Hirano discloses an embellishing die 3 with a first side 310 having a first embellishing surface and a second side 320 having a second embellishing surface as shown in Figure 22 of Hirano. Hirano further discloses a press 31,32 for pressing media X against the die to embellish the media X (also shown in Figure 22).

With respect to claim 15, Figure 22 of Hirano shows that the first and second embellishing surfaces are embossing surfaces.

With respect to claim 17, the press 31,32 disclosed by Hirano is a roller press in the sense that 31 and 32 are rollers.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 12, 18 and 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuda (JP 8-090720) in view of Bradley et al. (US 4,867,057).

With respect to claim 12, Tsuda discloses the claimed system for embellishing media except for the press. Figure 3 of Tsuda shows an embellishing die with first and second sides that can be used for embellishing media pressed against each of the sides. Bradley et al. teaches an embossing press with a die 20. It would have been obvious to combine the teaching of Bradley et al. with the embellishing die disclosed by Tsuda for the advantage of applying large pressing forces allowed by the die press taught by Bradley et al.

With respect to claim 18, Bradley et al. teaches an elastomeric embossing pad 33 (col. 5, lines 12-15) which can be made of synthetic rubber (col. 5, lines 31-35). It would have been

With respect to claim 19, Bradley et al. discloses a rigid platen plate 32 for pressing the media, the embellishing die 20 and the elastomeric pad 33.

With respect to claim 20, this claim only contains functional recitations of how the media embellishing die is to be used. The die disclosed by Tsuda has the capability to be used in this manner. The die could be used in one pressing and the moved to a different location and turned over and then pressed on a media a second time.

Allowable Subject Matter

10. Claims 5, 7, 16, 21 and 19-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claims 23-29 allowed.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Priesmeyer is cited to show another example of an embellishing die with two sides.

Response to Arguments

13. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

This action has been made non-final since the previous allowance of some claims has been withdrawn in light of newly found references.

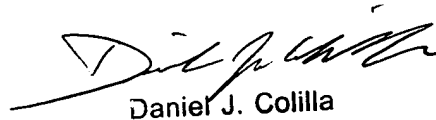
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Colilla whose telephone number is 571-272-2157. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2854

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 13, 2005



Daniel J. Colilla
Primary Examiner
Art Unit 2854